

REMARKS

Claims 1-6 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Noborimoto et al. (U.S. Patent Application No. 2002/0085467) (hereinafter "Noborimoto"). Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Noborimoto. These rejections are respectfully traversed for at least the following reasons.

In the Final Office Action, the Examiner maintains his previous assertion that Noborimoto discloses all of the features of claims 1-6 of the instant application. In Applicants' previously-filed arguments, a detailed explanation was provided of how Noborimoto does not teach or suggest a combination of features including "a first electrode section ... having a first electrode pattern for correcting aberration concerning a first optical disc" and "a second electrode section ... having a second electrode pattern for correcting aberration concerning a section optical disc different from the first optical disc in type."

The Examiner responds to these arguments at page 4 of the Final Office Action by making a general assertion that "...it would be obvious to adapt one electrode to work for one disc type and another electrode to work for another disc type as discussed above." However, earlier in the Final Office Action, at pages 2-3, the Examiner concedes that Noborimoto "does not disclose that the first electrode patter[n] corrects for aberration in only the first disc type."

The Examiner nevertheless then goes on to conclude that it would have been obvious to one having ordinary skill in the art "to configure one of two electrodes to work with one disc type and the second of two electrodes to work with another disc type, since it has been held that the recitation that an element is 'adapted to' perform a function is not a positive limitation..."

The Examiner cites to In re Hutchison, 69 USPQ 138 in support of these assertions at page 3 of the Final Office Action.

Applicants respectfully traverse these assertions at least because MPEP § 2111.04 provides specific directives regarding the use of clauses such as “adapted to” in a claim. The first sentence of this section starts by saying that “[c]laim scope is not limited by claim language that ... does not limit a claim to a particular structure.” However, the second sentence directs that there are specific “examples of claim language ... that may raise a question as to the limiting effect of the language in a claim” such as “adapted to” or “adapted for” clauses. In other words, this section of the MPEP specifically directs that such clauses may limit the scope of a claim based on the specific facts of any particular case.

For example, if a clause is material to patentability, it cannot be ignored as a limitation. In the instant case, the combination of the first and second electrode sections, each specifically configured in a certain arrangement, result in such patentable distinctions over the prior art. Accordingly, such claimed features are limitations of the claims that cannot be ignored in interpreting the claim scope as per MPEP § 2111.04.

Applicants also note that the In re Hutchison case cited by the Examiner is not referred to by MPEP § 2111.04 to any extent. In the In re Hutchinson case, the court did not consider the preamble phrase “adapted for use in the fabrication of a metal template or the like” to “constitute a limitation in any patentable sense.” See In re Hutchinson, 154 F.2d at 138, 69 USPQ at 141. This is quite different from the issues at hand in the instant application. In the present application, on the other hand, the “specifically configured for” language of the claims imposes a

capability requirement on each of the first and second electrode patterns respectively, i.e., each electrode pattern must be configured in the ways described in body of the claims.

Even further, claims 7 and 8 do not even include “adapted to” language, but instead include “specifically configured for” language that is understood to mean that the apparatus is structurally designed in a particular way. Noborimoto clearly does not include such first and second electrode sections “specifically configured” in the arrangements described in independent claims 1 and 4 of the instant application to any extent as will now be discussed in more detail.

As previously explained by Applicants in the response filed in this application on March 19, 2007, while Noborimoto discloses a first electrode plate 33 and a second electrode plate 34, as illustrated in its Fig. 5, each of these first and second electrode plates are not specifically configured to respectively correct aberration of one of a first and second type of optical disc. In other words, the first electrode plate 33 is not specifically configured to correct aberration of only a first type of optical disc and the second electrode plate 34 is not specifically configured to correct aberration of only a second type of optical disc that is different from the first type of optical disc. Applicants respectfully submit that this is a particularly distinctive feature of the instant application that is neither shown nor suggested by Noborimoto.

Instead, Applicants respectfully submit that the first electrode plate 33 of Noborimoto includes a pair of first electrode patterns 36a and 36b in addition to a second electrode pattern 37 having an elliptical shape. At the same time, the second electrode plate 34 of Noborimoto includes a common electrode pattern 38 facing the first and second patterns 36a, 36b and 37 of the first electrode plate 33. The second electrode plate 34 of Noborimoto is not provided “for correcting aberration concerning a second optical disc different from the first optical disc in

type,” as specifically described in each of independent claims 1 and 4 of the instant application. Instead, as described in each of paragraphs [0061] and [0063] of Noborimoto, the first and second patterns 36a, 36b and 37 of the first electrode plate 33 work together with the common electrode pattern 38 of the second electrode plate 34 regardless of whether the first or second types of magneto-optical disks 1a or 1b disclosed in Noborimoto are detected by the disk-type detecting unit 45 of Noborimoto.

As a result, Applicants respectfully traverse the Examiner’s assertion of obviousness with regard to the first electrode section and the second electrode section each respectively correcting aberration for a different optical disc type at least because Noborimoto clearly teaches away from any teaching or suggestion of configuring “one of two electrodes to work with one disc type and the second of two electrodes to work with another disc type” as asserted by the Office Action.

Applicants respectfully submit that this is a very specific arrangement that results in particular advantages as discussed, for example, at pages 18-23 of the instant application’s specification. As discussed above, Noborimoto does not teach, or even suggest, such an arrangement, but instead clearly teaches away from such an arrangement by disclosing that it’s first and second electrode plates 33 and 34 work together regardless of which type of magneto-optical disk is detected. To modify Noborimoto as suggested by the Office Action would “change the principle of operation” of the disclosure of Noborimoto in a way that is inconsistent with the directives of MPEP § 2143.01VI.

Applicants therefore believe, for at least the foregoing reasons, that the subject matter of the present invention claimed in each of independent claims 1 and 4 respectively of the instant application is not anticipated by the disclosure of Noborimoto. Accordingly, Applicants

respectfully assert that the rejections under 35 U.S.C. §§ 102(a) and 103(a) should be withdrawn because Noborimoto does not teach or suggest each feature of independent claim 1 or 4 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Also, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicants respectfully assert that the dependent claims are allowable at least because of their dependence from independent claim 1 or 4, and the reasons set forth above.

CONCLUSION

In view of the foregoing, Applicant submits that the pending claims are in condition for allowance, and respectfully request timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

Dated: October 23, 2007

By:

A handwritten signature in black ink, appearing to read "Paul A. Fournier", is written over a horizontal line.

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